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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,269	04/22/2004	Richard B. Evans	03-1272	6459
63759	7590	06/22/2009		
DUKE W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			EXAMINER LEE, LAURA MICHELLE	
			ART UNIT 3724	PAPER NUMBER
			NOTIFICATION DATE 06/22/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

Office Action Summary

Application No.

10/829,269

Applicant(s)

EVANS, RICHARD B.

Examiner

LAURA M. LEE

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/03/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 12-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed on 4/03/2009, in which claims 1-9 are currently amended and claims 10, 12-21 are withdrawn.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-9 of this application conflict with claims 1-11 of Application No. 12/205573. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either

cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

4. Claims 1-9 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-11 of copending Application No. 12/205573. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a system comprising an ultrasonic cutting tool with a tip, anvil, and grooves surface in alignment with the tip

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. (U.S. Patent 5,265,508), herein referred to as Bell in view of Hreha (U.S. Patent 4,077,290) and in further view of Miller (U.S. Patent 5,028,052) and Backlund (U.S. Patent 4,060,017).

Bell discloses a system comprising: an anvil (T-shaped member, 72; Figure 9-10) and a ultrasonic blade (ultrasonic cutting tool, 4), the anvil for providing support to a backed ply material during a cutting operation by the ultrasonic blade (4), the back ply material traveling in a first direction(towards the blade), the ultrasonic blade having a cutting profile (blade 46), the ultrasonic blade being operable to travel along a cutting path (along channel 73) the cutting path being orientated in a transverse manner relative to the first direction, wherein the anvil comprises a rigid base (bottom of T-shaped member) for securing the anvil to a cutting assembly; an inverted channel (channel 73) in the rigid base and coinciding with the cutting path; an insert (Lexan plastic strip 74) to mate with the channel; a surface (top of insert) on the insert to support the backed ply material, the surface being secured to the base (72); and a groove (impression by cutting blade) disposed upon the surface and coinciding with the cutting path (see col. 9, lines 38-48), the groove having a curved profile corresponding to a tip portion (46) of the cutting profile, the groove providing support during the cutting operation, wherein a backing of the backed ply material is urged into the groove during the cutting operation.

To the extent that it can be argued that the blade does not create a groove, or impression in the surface during the cutting action, it is further noted that Bell discloses

that within the channel (73), as previously disclosed as the third surface, that a Lexan plastic strip 74 can also be employed along the cutting axis. Lexan plastic is a polycarbonate resin thermoplastic well known as a trademarked material for its strength and impact resistance. Providing a strip of the plastic under the ultrasonic cutting blade provides an impact resistance strip that be easily removed and exchanged as it becomes worn out. Although thermoplastic materials are high molecular weight plastics, whose importance was established by the applicant's specification, to the extent that it can be argued that Bell does not specifically point out how this plastic strip is intended or would function under pressure of the ultrasonic blade, attention is first directed to Miller in evidentiary support that Lexan plastic is capable of deforming under pressure, as similar to applicants insert. Miller discloses a golf mat that also utilizes a sheet of Lexan plastic to form the base member. Miller discloses that although the Lexan base member is self supporting, it will deform if a load is placed thereon. Thereby, Miller provides evidence that should impact upon the Lexan plastic strip occur, it would be expected for the sheet to deform. Furthermore, evidencary evidence is also shown by Backlund, in that plastic materials are known to function in a protective, deformable manner. Backlund discloses a similar situation in which a cutting blade (16) is being employed against an anvil surface (14). Backlund discloses the use of a film (24) to protect the anvil surface from being marred by the cutting blade. This film can be one of number of suitable deformable materials; such as polyethylene, polypropylene, polyamides, polytetrafluoroethylenes, and the like. Backlund discloses that when the cutting blade contacts the film, the film is deformed, creating a groove the

shape of the cutting blade, this protects the underneath supporting anvil surface.

Thereby, Miller provides evidence that should impact upon the Lexan plastic strip occur, it would be expected for the sheet to deform as similarly shown by Backlund, as was its obvious purpose in the Bell anvil. Therefore, to the extend that it can be argued that Bell does not specifically state that the Lexan plastic strip is for providing a deformable material, such that should the blade contact the plastic a groove would occur, it would be obvious to one having ordinary skill in the art to employ the blade to make contact with the plastic strip such that the material was completely severed and the both the anvil and cutting edge were protected. The deformation creating a groove complimentary to the profile of the ultrasonic cutting blade and providing a third surface along the strip at a third height capable of being relatively below the first height and the second height to support the backed ply material.

Furthermore, Bell does not disclose that the channel is an inverted "T" shape, nor that the insert is also "T" shaped. However, attention is directed to Hreha that discloses another insert possessing an inverted T-shape that mates with a corresponding inverted -T shaped channel. Hreha discloses that providing inserts of a variety of shapes (see at least Figure 2 and 7) is well known in the art as they allow the insert to be removably secured within the channel. T-shaped inserts unlike rectangular inserts hinder the movement of the insert in the forward direction. It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the inserts of Weeks to comprise a T-shape as taught by Hera as T-shaped inserts are old and well known in the art for improvements in more secure, yet detachable connections.

In regards to claim 5, the modified device of Bell discloses wherein the insert (74) comprises a compliant material (Lexan plastic).

In regards to claim 7, the modified device of Bell discloses wherein the insert (74) comprises a polymeric material (Lexan plastic).

In regards to claim 8, the modified device of Bell discloses wherein the polymeric material comprises an ultra high molecular weight polymer (Lexan plastic is a high molecular weight polymer).

7. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. (U.S. Patent 5,265,508), herein referred to as Bell and Hera, Miller, Backlund (U.S. Patent 4,060,017), and also Pilkington (U.S. Patent 4,920,495), Gerber et al. (U.S. Patent 4,373,412) and Greve (U.S. Patent 5,072,640)

The modified device of Bell discloses the claimed invention except for the material of the anvil. It is first noted that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. As applicant claims that the anvil could be a metal, high pressure laminate, polymeric material, or a resin, apparently the material of the anvil is not very critical, in as long as the anvil structure is then capable of providing a solid, supporting surface to interact with the ultrasonic cutter. Furthermore, the use of strong, durable materials, such as metals, plastics, and laminates for anvils in combination with cutters, ultrasonic or otherwise, is old and well known in the art as supported by Backlund, Greve, Pilkington,

and Gerber. One having ordinary skill in the art at the time of the invention would have been similarly motivated to have designed the Bell anvil to be comprised of a well known structurally supportive material, as the claimed materials were well known for use in the anvil art and the modification would have yielded nothing more than predictable results of a structurally supportive cutting surface.

In regards to claim 8, the modified device of Bell discloses wherein the anvil comprises a metal. (see Pilkington, steel table, 86; Gerber et al. cutting support surface, 80, comprised of either aluminum, other metals, fiberboard, hard plastic, synthetic materials (col. 4, lines 15-20); Greve anvil, 52, plastic, metal, Polyethylene, or Delrin)

In regards to claim 9, the modified device of Bell discloses wherein the anvil comprises a high pressure laminate (see Greve anvil, 52, plastic, metal, Polyethylene, or Delrin (high pressure laminate) see col. 4, lines 4-9; col. 8, lines 46-49)

In regards to claim 10, the modified device of Bell discloses wherein the anvil comprises at least one of polymeric material and a resin (see Gerber et al. cutting support surface, 80, hard plastic (col. 4, lines 15-20); Greve anvil, 52, plastic, Polyethylene, or Delrin (see col. 4, lines 4-9; col. 8, lines 46-49).

8. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. (U.S. Patent 5,265,508), herein referred to as Bell in view of Hreha (U.S. Patent 4,077,290) and in further view of Miller (U.S. Patent 5,028,052) and Backlund (U.S. Patent 4,060,017). The modified device of Bell discloses the claimed invention except that surface comprises metal. It would have been obvious to one having ordinary skill in

the art at the time the invention was made to substitute the resilient Lexan plastic for another material such as metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

9. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. (U.S. Patent 5,265,508), herein referred to as Bell in view of Hreha (U.S. Patent 4,077,290) and in further view of Miller (U.S. Patent 5,028,052) and Backlund (U.S. Patent 4,060,017). The modified device of Bell discloses the claimed invention except that insert (74) comprises a high pressure laminate or nylon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the resilient Lexan plastic for another material such as a HPL or nylon, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

10. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **LAURA M. LEE** whose telephone number is (571)272-8339. The examiner can normally be reached on **Monday through Friday, 8:00am to 4:30pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Boyer Ashley** can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laura M Lee/
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